REMARKS

Claims 49-81 and 83-111 are pending in the present application. Reconsideration of the pending claims is respectfully requested for the reasons discussed below.

In the non-final rejection mailed November 22, 2004, the Examiner rejected claims 49, 50, 55, 56, 61, 62, 83-84, 90-95, 97-98 and 111 under 35 U.S.C. 102(b) as being unpatentable over Friedman et al., U.S. Patent No. 5,928,693. The Examiner asserted that,

> Friedman et al. disclose all the limitations of the above cited claims. The language of the claims does not exclude the acetylated starch; the starch can be obtained from barley. which meets the claimed limitation of the composition being free of corn starch.

An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. *Crown Operations Intern., Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1375 (Fed. Cir. 2002). Applicants respectfully submit that the '693 patent does not describe Applicants' claimed subject matter, let alone describe the claimed invention with sufficient clarity and detail to establish that Applicants' claimed subject matter existed in the prior art and that such existence was recognized by persons of ordinary skill in the field of the present invention. The '693 patent does not fairly disclose or suggest that the acetylated starch can be obtained from barley alone. Friedman et al. disclose a coating for french fries that uses a 55-85% acetylated starch component which is made from a crossbred or genetically modified plant containing the dull sugary-2 (dusu2) or amylose extender dull (aedu) genotype. (Friedman et al., col. 2, lines 1-5). Significantly, the particular reference in the '693 patent to which the Examiner apparently refers in making her latest rejection and the only reference to barley in the entire patent, in context, states:

> It has been found that the amylose extender (ae) gene is present in maize and barley, and that cereal grains such as maize contain the dull (du), and sugary-2 (su2) genotypes. Maize (corn) is the

> preferred plant source for the starches used in the present invention.

(Friedman et al., col. 2, lines 54-58).

Applicants respectfully submit that, taken as a whole, the '693 patent, like other prior art references, teaches away from Applicants' claimed compositions that are "free of cornstarch" and toward compositions that include corn starch or genetically modified starches derived from corn. Initially, Applicants note that the '693 patent teaches the use of a dusu2 starch, a corn starch (*See* col. 3, lines 23-24; col. 4, lines 66-67; and the various Examples). Example 5 specifically shows a comparison of the "acetylated dusu2 corn starch" and "acetylated high amylose corn starch." Also, the claims require the acetylated starch be from the dull sugary 2 "amylose extender dull" (significantly not solely the amylose extender gene, which is the gene passingly mentioned as present in barley and maize), both of which, as a practical matter, would be corn starches.

Applicants previously discussed the '693 patent in their Response mailed July 8, 2003. Submitted along with that Response was a Declaration of John Stevens. Applicants have resubmitted that Declaration of John Stevens along with this Response because the Examiner indicated she had not considered the Declaration in her Office Action mailed November 26, 2003. As similarly discussed in Applicants' July 8, 2003, Response, as a practical matter, it is believed that the only starches available which contain either the dull sugary 2 genotype or the amylose extender dull genotype are genetically modified corn starches. (John Stevens Decl., dated July 8, 2003, pars. 17 and 26). John Stevens included a paper submitted by David V. Glover, Department of Agronomy, Purdue University (Exhibit 10 of John Stevens Decl., dated July 8, 2003), which supports this conclusion.

Thus, the '693 patent is distinguished on the same basis as the other prior art, in that the food coating composition of the '693 patent is not "free of corn starch." Indeed, the '693 patent indicates that corn is the preferred plant source for the starches and that only corn contains the dull and sugary 2 genotypes. While the '693 patent indicates that barley may contain the amylose extender gene, one cannot get the amylose extender dull combination without employing corn. Accordingly, the '693 patent does not anticipate claims 49, 50, 55,

56, 61, 62, 83-84, 90-95, 97-98 and 111 (or the claims that depend from any of these claims) or render them obvious for at least the reasons discussed above.

The Examiner has also rejected claims 51-54, 57-60, 63-81, 85-89, 96, 98, and 99-110 under 35 U.S.C. 103(a) as being unpatentable over Friedman et al. in view of Horn et al. (6,080,434). In this regard, the Examiner admits:

> Friedman et al do not disclose adding ungelatinized low amylose content potato starch, adding color agent, sugar, stabilizing agent, using high solubility dextrin, applying the coating composition as a dry mix, the holding time, freezing without parfrying, holding at room temperature and cooking after coating without freezing.

Significantly, it is improper to pick and choose among individual parts of assorted prior art references as a mosaic to recreate a facsimile of the claimed invention. *Akzo N.V. v. U.S. Int.'l Trade Comm'n*, 808 Fed. 2d 1471, 1481, 1 U.S.P.Q. 2d 1241, 1246 (Fed. Circuit 1986) (quoting *W.L. Gore and Assocs., Inc. v. Garlock, Inc.*, 721 Fed. 2d 1540, 1552, 1220 U.S.P.Q. 303, 312 (Fed. Circuit 1983)). The Examiner has chosen among individual parts of the Horn reference to recreate the claimed invention. For example, the Examiner argues that "Horn et al. teach to add up to about 5% modified pregelled potato starches to provide viscosity control and suspension of the solids in the batter." The Horn et al. reference teaches use of potato starches; however, the Examiner has made at least two errors in this regard. First, the Examiner has only selected individual parts of Horn et al., for example, Horn et al.'s use of modified potato starches to provide viscosity, control, and the use of other ingredients such as gums, flavoring, and a coloring agent. However, Horn et al. also generally teaches the inclusion of corn starch. At least the "Summary of the Invention" and the claims of the '434 patent explicitly state that the slurries of the '434 patent include "at least 2% by weight of a crosslinked dent corn starch." Accordingly, when taken for its entire teaching and not selecting individual parts to recreate the claimed invention, the Horn et al. reference teaches away from Applicants' claimed invention.

Second, in the '693 patent, Friedman et al. teach away from the inclusion of potato starches. A reference is said to teach away when "a person of ordinary skill in the art, upon

reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent form the path that was taken by the applicant." *In re Gurley* 27 F.3d 551, 553 (Fed. Cir. 1994). The court in *Gurley* went on to say that a reference that teaches away cannot be the basis of a *prima facie* obvious rejection. *Id* at 553. In the "Background of the Invention," Friedman et al. state:

> Potato starch is often limited in commercial availability and usually commands a premium price. Tapioca starch is also often limited in supply and usually commands a premium price also. There is a need for a less expensive, more readily available clear coat composition for use on potato products which will protect the fried potato and allow the fried potato product to withstand the deleterious effects of a heat lamp.

('693 patent, col. 1, lines 36-43). Friedman et al. stress that their genetically modified starches replace the potato starches, which often is "limited in commercial availability and usually commands a premium price." Applicants respectfully submit that the '693 patent to Friedman et al. teaches away from its combination with potato starches generally. Therefore, for at least the above two reasons, claims 51-54, 57-60, 63-81, 85-89, 96, 98, and 99-110 would not have been obvious.

Moreover, claims 52-54, 58-60, 64-72, 85-89, 96, 98, and 99-100 would not have been obvious for at least one additional reason. Horn et al. state that aqueous slurries may have up to about 5% by weight of an unmodified pregelled potato starch for viscosity control. The Examiner then mistakenly concludes, without citing any reference, that "it would have been obvious to use pregelatinized [starch] or ungelatinized [starch] depending on the solubility rate desired." This is simply not true. "Clear coat" compositions, which are nomenclatured as such by the french fry coating industry because they result in a substantially clear coating on a substrate upon thermal processing of the coating on the substrate, are at least mildly agitated while being held in a wet slurry batching/holding container (Second Decl. of John Stevens, ¶ 7). Agitation is utilized to help ensure even dispersement of the dry batter solids within the slurry. (Second Decl. of John Stevens, ¶ 8). Use of ungelatinized starch, as required by claims 52-54, 58-60, 64-72, 85-89, 96, 98, and 99-100 would not have been

obvious. Ungelatinized starch helps ensure a relatively constant viscosity, which in turn helps maintain relatively constant wet batter pick up on the finished products and thereby a relatively constant coating. (Second Decl. of John Stevens, ¶ 9). Alternatively, if a pregelatinized starch (the starch in Horn et al.) is utilized, even the mild agitation used to keep the dry batter in suspension will continually lower the viscosity due to the deterioration of the starch. This therefore requires the addition of more dry solids to maintain viscosity, which usually results in altered or inconsistent coatings being applied to the substrate being coated due to the difficulty of adding the appropriate amounts of dry solids while agitation is in process. (Second Decl. of John Stevens, ¶ 10). Even if viscosity is somehow able to be maintained by constantly adding more dry solids, the finished product's color, flavor, and texture attributes would constantly be altered due to the increased amounts of dry batter solids. (Second Decl. of John Stevens, ¶ 10). Accordingly, in addition to the reasons discussed above regarding the potato starch generally, claims 52-54, 58-60, 64-72, 85-89, 96, 98, and 99-100 directed toward the use of ungelatinized potato starch would also not have been obvious for this additional reason.

The Applicants have made a concerted effort to place the present application in condition for allowance, and a notice to this affect is earnestly solicited. In the event there are any remaining formalities or other issues needing Applicants' assistance, Applicants request the Examiner to call the undersigned attorney.

Respectfully Submitted,

CHEREE L. B. STEVENS ET AL.

By: Price, Heneveld, Cooper, DeWitt & Litton, LLP

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Date

Todd A. Van Thomme 44 285
695 Kenmoor Ave. SE
P. O. Box 2567
Grand Rapids, MI 49501
(616) 949-9610

TAV/jrf